

REMARKS

Claims 12, 14-22 and 88-118 are currently pending in the application. Applicant has amended claims 12, 15 and 98-117. Applicant requests reconsideration of the application in light of the following remarks.

Request to Admit the Amendment

Applicant believes that the foregoing amendment complies with the Examiner's requirement of form and further believes that this amendment presents the rejected claims in better form for appeal. Pursuant to 37 C.F.R. § 1.116(a), Applicant requests the Examiner admit the amendment. However, even if the Examiner decides not to admit the amendment under 37 C.F.R. § 1.116(a), Applicant respectfully requests the Examiner admit the amendment pursuant to 37 C.F.R. § 1.116(b). The foregoing amendment is presented to amend the form of claims 98-117 to present the claims as program product claims, and to further refine independent claims 1 and 15. The amendment was not previously presented, as it was not believed necessary in Applicant's most recent response. Upon these good and sufficient reasons for why the amendment is necessary and was not earlier presented, Applicants request the Examiner admit the amendment pursuant to either 37 C.F.R. § 1.116(a) or 37 C.F.R. § 1.116(b).

Telephone Interview

Applicant's attorney wishes to thank the Examiner for his courtesy and time during a telephone interview that was held on February 2, 2004. The Examiner's comments and insight were very helpful in preparing this response. It is hoped that the comments below reflect the spirit of the interview.

Rejections under 35 U.S.C. § 101

Claims 98-118 were rejected by the Examiner under 35 U.S.C. § 101 because they are directed to non-statutory subject matter, specially, as directed to an abstract idea. To overcome this rejection, the Applicant has amended the claims by reforming claims 98-117 into program product claims as discussed with the Examiner in the telephone conference of February 2, 2004 to overcome the section 101 rejection. Claim 118 is dependent upon independent claim 15 and, was already in program product format. Applicants respectfully request the non-statutory subject matter rejection be withdrawn.

Rejections under 35 U.S.C. §102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 15-19 were rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Dedrick (U.S. Patent No. 5,717,923, hereinafter "Dedrick"). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Independent claim 15, as amended, recites a program product comprising: "an advertising plan optimization mechanism for generating a plan for providing an advertisement message to a preselected group of potential message recipients, the advertising plan optimization mechanism modifying an advertising plan for advertising the message to the preselected group within an advertising schedule and evaluating a resulting advertising plan to achieve one of an improved and an optimal advertising plan for the message"

As was discussed in the telephone conference with the Examiner on February 2, 2004, Dedrick discloses a concept that addresses a problem significantly different from Applicant's invention of claim 98 and, as a result, does not anticipate Applicant's claim 15. The Dedrick invention relates to selection and formatting of an advertisement from a database of advertisements for a single audience member who is accessing a web site. *See* Dedrick, col. 7, line 23 to col. 9, line 25. When the single audience member accesses the web site, the database accesses the audience member's demographics and personal settings and determines which advertisement is the correct advertisement for this audience member based upon her demographics and personal settings. *Id.* Thus, there is no advertising "plan", no advertisement "schedule", and no modifying of any advertisement plan in Dedrick for presentation to any group of potential recipients. The "schedule" referenced in the most recent Office Action at Dedrick, col. 14, lines 33-42 is not an advertisement schedule, but is a section of the web site where a consumer can enter the time and date to receive the service being purchased. It is not an "advertising schedule" "for advertising the message to a preselected group" as recited in claim 15, it is a calendar for scheduling the delivery of services (not advertisements).

The claimed invention of claim 15 relates to optimizing an advertisement plan for presenting an advertisement message to a group of potential message recipients. Thus, the problem involves determining an advertising plan for providing one message to many possible recipients, not instantaneous matching of one recipient with the best advertisement like in Dedrick. Because Dedrick does not disclose each and every element of claim 15, Dedrick cannot anticipate claim 15. Dependent claims 16-19, which depend from claim 15, are allowable over Dedrick, among other reasons, for depending from allowable claim 15.

Claims 98-118 were rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Related Art-Applicant background invention section (hereinafter "Related Art"). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Applicant's related art/background section of the application explains generally the disassociated information and methods that were available in the art prior to Applicant's invention. The most recent Office Action attempts to take statements from the background section out of context and improperly read into the statements meaning, purpose, and combined application that is simply not there. For example, in relation to determining an exposure value, the Office Action recites page 4, lines 16-19 that explains a deficiency in the art related to educated guesses of previous systems. In addressing the characteristics value of the claim, the Office Action recites page 3, lines 11-15, which mentions the demographics of an audience, but makes no mention of assigning the demographics a value. As another example, page 3, lines 18-19 states "It is most desirable to create an optimal campaign which effectively utilizes a finite combination of resources to communicate to the target audience." The Office Action alleges that this anticipates the claim element relating to a method of calculating a value of exposing an audience member to an advertisement that states, "combining the exposure value with the characteristics value to produce a combined value of exposing the audience member to the advertisement." Other than the word "combination" at page 3, lines 18-19, there is no relation between these statements.

As recited in claim 98, as amended, claim 98 relates to a "program product for optimizing an advertising plan for presentation of an advertisement message to a preselected group of potential message recipients". Thus, claim 98 relates to establishing a plan for presenting a message to a group that is to potentially be exposed to this message when the plan is implemented. The discussions in the background section generally relate to the various labor intensive and difficult manual processes attempted by previous firms. None of the processes describe involve the novel combination recited in claim 98.

The most recent Office Action's attempt to read content, meaning and association into the background that is not present is an improper basis for rejecting claims 98-118.

More generally, the rejections provided by the Examiner for claims 98-118 relate generally to finding anticipation for the various “exposure value”, “characteristics value” combined values, adjusting the values, and the like recited in the claims. The background section does not discuss any values that are determined relating to exposure, characteristics, any combinations of those values or adjusting of those values to obtain an optimized plan, to calculate scores for any of the advertising plans, or to determine which plans are likely to be optimal for a particular group.

The reason the background section does not include the elements of the claimed inventions, but instead includes only separate discussions of the general aspects of broadcasting advertisement messages that may be important, is that Applicant has divined a way to reduce other general but important information to values which are then compared, combined and/or adjusted to create an optimal plan for presenting the advertisement message. This is accomplished automatically so that the various advertising plans can be easily compared for more rapid selection of an optimal plan for a particular advertisement message. The specific elements of claims 98-118 are not disclosed or found in the background section of Applicant’s disclosure. Accordingly, the background section does not anticipate claims 98-118.

Applicants respectfully request that the anticipation rejections of claims 15-19 and 98-118 be withdrawn.

Rejections under 35 U.S.C. §103

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants' disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

Claims 12, 14 and 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick (U.S. Patent No. 5,717,923, hereinafter "Dedrick"), in light of Data Mining Techniques to Gain Insight Into Your Data – 12/1995 - Cipolla (hereinafter "Cipolla"). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Independent claim 12, as amended, recites, "computer system for optimizing an advertising schedule for an advertisement message, the computer system comprising: . . . a user interface . . . for improving and optimizing an advertising plan for the message within an advertising schedule for the message, which plan is characterized for presentation to a plurality of audience members according to a plurality of indices."

As was discussed in the telephone conference with the Examiner on February 2, 2004, Dedrick discloses a concept that addresses a problem significantly different from Applicant's claimed invention and, as a result, does not make Applicant's claim 12 obvious. The most recent Office Action attributes all of the elements except a data mining tool to Dedrick. However, the Dedrick invention relates to selection and formatting of an advertisement from a database of advertisements for a single audience member who is accessing a web site. *See* Dedrick, col. 7, line 23 to col. 9, line 25. When the single audience member accesses the web site, the database accesses the audience member's demographics and personal settings and determines which advertisement is the correct advertisement for this audience member based upon her demographics and personal settings. *Id.* Thus, there is no advertising "plan" and no advertisement "schedule" for presentation to any plurality of audience members. The system of Dedrick does not have a user interface for improving and optimizing an

“advertising plan for the message within an advertising schedule for the message . . . for presentation to a plurality of audience members . . .” as recited in claim 12. Cipolla does not add these elements missing from Dedrick. Accordingly, independent claim 12, is not made obvious by the combination of Cipolla and Dedrick, and is allowable. Dependent claim 14 is allowable over the combination of Dedrick and Cipolla, among other reasons, for depending from allowable claim 14.

Dependent claims 20-22 are allowable over the combination of Dedrick and Cipolla, among other reasons, for depending from allowable claim 15. Neither Dedrick, as discussed above with reference to claim 15, or Cipolla, alone or in combination, teach or suggest the elements of claims 20-22.

Dependent claim 88 is allowable over the combination of Dedrick and Cipolla, among other reasons, for depending from allowable claim 12.

Dependent claims 89-90 are allowable over the combination of Dedrick and Cipolla, among other reasons, for depending from allowable claim 12. Specifically also, the most recent Office Action cites Dedrick, col. 5, lines 50-59 for support to make obvious the claim language “wherein the audience member data indicate exposure to advertisements on television.” However, the section of Dedrick cited bares no relation to the exposure of an audience member to television advertisements. It relates to a personal profile database to store information about the user for use in facilitating ordering of items displayed in Internet advertisements. There is no mention in this Dedrick section of television application or storage of exposure data for whether the audience member has been exposed to any particular advertisements.

Dependent claims 91-95 are allowable over the combination of Dedrick and Cipolla, among other reasons, for depending from allowable claim 12. Specifically also, the most recent Office Action cites Dedrick, col. 1, lines 24-26 for support to make obvious claim language relating to storing audience member data to indicate exposure of the audience

member to advertisements. However, the section of Dedrick cited does not indicate storage of any audience member data to indicate exposure of the audience member to advertisements. Lines 21-26 of col. 1 state, "The current wide-ranging use of computer systems provides a relatively large potential market to providers of electronic content or information. These providers may include, for example, advertisers and other information publishers such as newspaper and magazine publishers." Applicant does not deny that people have been exposed to advertisers, newspaper and magazines. Applicant does, however, dispute that Dedrick discloses storing, in combination with the audience member data, an indication of exposure of the audience member to advertisements.

Dependent claims 96-97 are allowable over the combination of Dedrick and Cipolla, among other reasons, for depending from allowable dependent claim 21 and independent claim 15. Specifically also, the most recent Office Action cites Dedrick, col. 4, lines 44-48 for support to make obvious the claim language "wherein the media exposure records comprise television viewing records." However, the section of Dedrick cited bares no relation to television viewing records. It relates to the various electronic formats that can be transmitted over the computer system using the software tools provided by the Dedrick system.

Applicants respectfully request that the obviousness rejections of claims 12, 14 and 20-22, and 88-97 be withdrawn.

Regarding Doctrine of Equivalents

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.


CONCLUSION

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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